

REMARKS

Claims 1-19 continue to be the pending claims in the application.

Reconsideration of the application in light of the remarks which follow is respectfully requested.

The November 12, 2008 Final Office Action rejected Claims 1-19 under 35 U.S.C. § 103(a) as being unpatentable over Ahluwalia (US 5,965,257) in view of Langer (US 4,600,634) and GB 2167060 (GB '060) or Dugan (US 4,994,317) or Dombeck (US 6,228,497).

Prior to filing an appeal brief, Applicants respectfully request clarification as to the rationale relied upon by the Office for maintaining the outstanding obviousness rejection in view of the evidence of unexpected results pointed out by Applicants in the remarks filed on February 6, 2009.

In the February 18, 2009 Advisory Office Action, the Office states that “[t]he test results in these paragraphs do not fairly compare the combination of Ahluwalia, Langer, GB '260, Dugan, or Dombeck to that of the present invention” (emphasis added). Applicants respectfully submit that the Office appears to be relying on an improper standard for considering obviousness in view of unexpected results.

In accordance with MPEP § 2141, the Office must consider unexpected results when determining whether a claimed combination is obvious. When the Office considers the weight of secondary considerations such as unexpected results, the required nexus is between the claimed invention and the evidence of the secondary considerations. MPEP § 716.01(b). Moreover, when there is a nexus between the merits of the claimed invention and the evidence of secondary considerations, the evidence must be given substantial weight in the determination of obviousness. *Id.*

In stark contrast to the Office's position, there is simply no requirement that the evidence of the secondary considerations “fairly compare” the Office's proposed combination to

Applicants' claimed invention. For at least this reason, the Office's obviousness analysis is believed deficient and should be withdrawn.

Applicants also respectfully submit that the standard applied by the Office for evaluating obviousness is illogical. In order to achieve a *prima facie* case of obviousness against Applicants' claimed invention, the Office has the burden of arriving at a legally permissible and technically feasible combination that addresses each recitation recited in Applicants' claims. Accordingly, *assuming arguendo*, that the Office did achieve its burden of achieving a *prima facie* case of obviousness, test results exhibited by the combination proposed by the Office should, to some extent, be similar to those exhibited in the claimed invention. Evidence to the contrary would tend to demonstrate that the Office has failed to achieve its burden, rendering the obviousness rationale relied upon deficient to start with. For at least these reasons, it is respectfully submitted that the probative value of the standard applied by the Office lacks merit for evaluating secondary considerations in order to overcome a *prima facie* case of obviousness.

Applicants respectfully request the Office to conduct an obviousness analysis in view of the correct standard referenced above and discussed further in MPEP § 716.01. Should the Office maintain the outstanding obviousness rejection, then Applicants respectfully request that the Office clearly articulate the rationale relied upon in view of Applicants' evidence of secondary considerations.

Furthermore, with particular regard to the evidence of unexpected results submitted, Applicants again note that the tested samples were derived from the very same primary reference, Ahluwalia '257 (owned by the assignee of the present application), that the Office proposes modifying to arrive at the presently claimed invention. Again, the three samples tested by Applicants were:

1) the Ahluwalia '257 composite material (which does not include a clay filler)
modified to have aluminum foil adhered thereto.

2) the Ahluwalia '550 composite material unmodified (which is derived from the
Ahluwalia '257 composite material with a clay filler added), and

3) the presently claimed invention (Ahluwalia '550 composite material modified
to have aluminum foil adhered thereto).

Using the above numbering for the samples, the time to burn for the cotton balls placed on top of sample #1 was 1 to 5 minutes, while the time to burn for the cotton balls placed on top of sample #2 was 14 minutes. In stark contrast however, the cotton balls placed on top of the sample #3 did not burn even after 8.5 hours. These data points clearly indicate that the mere addition of aluminum foil or a clay filler, each on their own, failed to suggest the significant improvements demonstrated when both are included in the manner set forth in the presently claimed invention.

In view of the above unexpected results, Applicants respectfully submit that the claimed combination of elements is not obvious even if the Office could provide a proper *prima facie* case of obviousness against Claims 1 and 16.

Therefore, Applicants respectfully request that the rejection of claim 1-19 under 35 U.S.C. § 103(a) as being unpatentable over Ahluwalia in view of Langer and GB '060 or Dugan or Dombeck be withdrawn.

Attorney Docket No. 03398.000004

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address given below.

Respectfully submitted,

/Alicia A. Russo/
John D. Murnane
Registration No. 29,836

Alicia A. Russo
Registration No. 46,192
Attorneys for Applicants

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3800
Facsimile: (212) 218-2200

FCHS_WS 2913686v1